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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 46521-56183 | |
| I hereby certify that this correspondence is being electronically transmitted to the USPTO via the EFS Web on: on <u>January 9, 2008</u> Signature <u>[Signature]</u> Typed or printed name <u>Kevin M. Kercher</u> | | Application Number 10/720,330 Filed November 24, 2003 First Named Inventor McCormick Art Unit 1797 Examiner Bowers, Nathan A. | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> | | | |
| <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,408</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p style="text-align: right; margin-right: 100px;"> <u>[Signature]</u> Signature <u>Kevin M. Kercher</u> Typed or printed name <u>(314) 552-6345</u> Telephone number <u>January 9, 2008</u> Date </p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> | | | |
| <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted. | | | |

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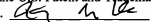
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Kevin M. Kercher
Reg. No. 33,408

| | | |
|---|---|--------------------------------|
| In re application of: | : | Examiner: Nathan Andrew Bowers |
| James B. McCormick | : | |
| Serial No.: 10/720,330 | : | Group Art Unit: 1797 |
| Filed: November 24, 2003 | : | Confirmation No. 4303 |
| For: Apparatus and Method for Preparing | : | Customer No. 021888 |
| Tissue Samples for Histological Examination | : | |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks are presented in response to the Patent Office Final Rejection mailed on November 15, 2007.

REMARKS

Rejection Under 35 U.S.C. § 103(a):

Claims 6 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mathus et al. (U.S. Patent No. 5,856,176) in view of Berry et al. (U.S. Patent No. 5,240,854). First and foremost, Mathus et al. is directed to a culture dish or Petri dish. Mathus et al. discloses: "Culture dishes are known and widely used in laboratory environments for growing cell cultures, bacteria, viruses and the like. In the cell growth application, cell cultures are grown from tissue cell samples that are placed in the dish and covered with a liquid medium that promotes cell growth when the dish is placed in a controlled environment such as an incubator. For this application, the culture dish is typically sterilized and treated to promote the binding of cells to the dish surface. The grown cells can be removed from the dish to facilitate examination, or the user can examine the cells while in the dish, using an instrument such as a microscope. In another conventional application, tissue cells are grown in a semisolid (**rather than liquid**) medium that does not bind to the dish. Thus, the medium can be readily removed to recover the cells by simply turning over the dish." (Mathus et al., Column 1, Lines 10-25). Therefore, a Petri dish is defined as, "...a shallow, circular, glass or plastic dish with a loose-fitting cover over the top and sides, used for culturing bacteria and other microorganisms." petri dish. (n.d.).

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The American Heritage® Science Dictionary. Retrieved January 07, 2008, from Dictionary.com website: [http://dictionary.reference.com/browse/petri dish](http://dictionary.reference.com/browse/petri+dish). Claims 6 and 13 both specifically require and recite: "...wherein the plurality of apertures of the bottom wall of the second cassette allow **liquid paraffin** to flow from one of the first and second containers and into the other of the first and second containers while the first and second cassettes remain interlocked." It is respectfully believed that liquid paraffin flowing between two Petri dishes would absolutely destroy each Petri dish for its intended purpose of "culturing bacteria and other microorganisms."

Berry et al. discloses: "A multi-chamber cell-culture assembly has provision for even and continuous distribution of nutrient medium throughout each of the chambers. A device is constructed to provide large surface areas for cell growth relative to the chamber volumes." (Berry et al., Abstract, Lines 1-5). There is absolutely no motivation to modify the Petri dish disclosed in Mathus et al. with the cell-culture assembly that distributes nutrient since the distribution of nutrient would contaminate the culturing bacteria found in a Petri dish disclosed in Mathus et al. Moreover, liquid paraffin flowing between Petri dishes **would absolutely destroy the Applicant's Invention for its intended purpose**. It is respectfully believed that it is not unclear that liquid paraffin flowing between Petri dishes is completely undesirable and prevents the growing of cultures. Therefore, Mathus et al. clearly teaches away from the Applicant's Invention, as claimed, in addition to destroying the Applicant's Invention for its intended purpose.

The Supreme Court held in *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is "teaching away" from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the *Manual of Patent Examining Procedure* (M.P.E.P.) § 2141.02, which recites: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Moreover, "...if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Allowing liquid paraffin to flow between adjacent Petri dishes would render the

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invention disclosed in Mathus et al. completely unusable and there is no reason to combine the features of Berry et al. with Mathus et al. since the function and purpose of Mathus et al. would be utterly destroyed.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). In this case, Mathus et al. combined with Berry et al. would be very undesirable since flowing liquid paraffin between Petri dishes would absolutely prevent formation of a culture. Consequently, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959).

Moreover, there is no teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007). In determining obviousness, the proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. "To reject a claim based on this rationale, U.S. Patent Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following: (1) a **finding that the prior art included each element claimed**, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, **each element merely would have performed the same function as it did separately.**" (Federal Register / Volume 72, No. 195 / Wednesday, October 10, 2007 / Notices, Page 57529, "*Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*"). In this case, the Applicant's claimed invention functions in a totally different manner than as disclosed in Mathus with two interlocked tissue processing cassettes having liquid paraffin flowing between the tissue processing cassettes and the mere combination of a Petri dish from Mathus et al. with Berry et al. would absolutely not be sufficient. Therefore, it is respectfully believed that

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a proper rejection under 35 U.S.C. § 103(a), based on the United States Patent Office's own guidelines, cannot be made.

The facts are that the teaching, suggestion and motivation are to the contrary since Mathus et al. discloses a Petri dish used to grow cultures and any flow of fluids between Petri dishes destroys the intended purpose of Mathus et al. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 U.S.P.Q.2d 1329, 1335 (Fed. Cir. 2006).

Therefore, Claims 6 and 13 are respectfully believed to overcome the rejection under 35 U.S.C. § 103(a) as being unpatentable over Mathus et al. in view of Berry et al.

Claims 10-12 depend from independent Claim 6 and Claim 14 depends from Claim 13, which are respectfully believed to overcome the 35 U.S.C. § 103(a) rejection over Mathus et al. in view of Berry et al. in the same manner as Claim 6 and Claim 13 as described above. If an independent claim is not obvious, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

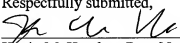
Therefore, Claims 10-12 and 14 overcome the rejection under 35 U.S.C. § 103(a) and are in condition for allowance.

Claims 7, 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mathus et al. (U.S. Patent No. 5,856,176) in view of Berry et al. (U.S. Patent Application No. 5,240,854) and further in view of Intengan (U.S. Patent No. 4,440,301). Claims 7, 8 and 9 depend from independent Claim 6, which is respectfully believed to overcome the 35 U.S.C. § 103(a) rejection over Mathus et al. in view of Berry et al. in the same manner as Claim 6 as described above. If an independent claim is not obvious, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, Intengan is directed to self-stacking **reagent** slides rather than interlocked tissue processing cassettes. A reagent is a "...substance used in a chemical reaction to detect, measure, examine, or produce other substances." reagent. (n.d.). The American Heritage® Dictionary of the English Language, Fourth Edition. Retrieved January 07, 2008, from Dictionary.com website: <http://dictionary.reference.com/browse/reagent>. Having liquid paraffin flowing between two

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reagent slides will destroy the intended purpose of these slides of providing a chemical reaction that can be viewed under a microscope.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). In this case, it is very clear that allowing liquid paraffin to flow between reagent slides would be extremely undesirable. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). "To reject a claim based on this rationale, U.S. Patent Office personnel must have: (1) a finding that **the prior art included each element claimed** and (2) a finding that **each element merely would have performed the same function as it did separately.**" (Federal Register / Volume 72, No. 195 / Wednesday, October 10, 2007 / Notices, Page 57529). It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) § 2143.03 that "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Consequently, it is respectfully believed to be axiomatic that a feature not disclosed in either Intengan, Mathus et al. or Berry et al., i.e., interlocking containers that provide the flow of paraffin cannot come into being by their combination. Therefore, Claims 7, 8 and 9 are patentable over Mathus et al. in view of Berry et al. and further in view of Intengan. In view of the remarks presented herein, it is submitted that the rejections of Claims 6-14 are made in error and should be withdrawn and the application allowed.

Respectfully submitted,
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